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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,470	02/07/2001	Cheree L. B. Stevens	ADV12 P300A	4695

277 7590 07/07/2005

PRICE HENEVELD COOPER DEWITT & LITTON, LLP  
695 KENMOOR, S.E.  
P O BOX 2567  
GRAND RAPIDS, MI 49501

EXAMINER

TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/778,470

Applicant(s)

STEVENS ET AL.

Examiner

Lien T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-81 and 83-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-81, 83-111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Claims 49,50,55,56,61-62, 83-84, 90-95,97-98 and 111 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedman et al for the same reason set forth in the previous office action.

Claims 51-54, 57-60, 63-81, 85-89, 96,98 and 99-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman et al in view of Horn et al for the same reason set forth in the previous office action.

In the response filed 4/20/05, applicant argues Friedman et al do not anticipate the cited claims because Friedman et al teach away from the claimed compositions that are free of cornstarch and toward compositions that include cornstarch or genetically modified starches derived from corn. This argument is not persuasive. Friedman et al disclose the amylose extender gene is present in maize and barley and that cereal grains such as maize contain the dull and sugary-2 genotypes. This disclosure clearly indicates that the starch is not derived solely from corn and can be from barley or other grain as long as the grain contains the required genotypes. Furthermore, even if the starch comes from corn, it is genetically and chemically modified; thus, it is no longer just cornstarch. The starch disclosed in the reference is acetylated starch which is not corn starch. Applicant further argues one cannot get the amylase extender dull combination without employing corn. Even if one employs corn to obtain the dull genotype, the resulting plant from which the starch is obtained is not just corn; it is a hybrid between barley and corn. Thus, the starch is not a cornstarch. The claims do not exclude genetically and chemically modified corn starch; they only exclude corn starch.

With respect to the 103 reference, applicant argues Horn et al teach the inclusion of corn starch and Friedman et al teach away from the inclusion of potato starches because they state that potato starch is often limited in commercial availability and usually commands a premium price. This argument is not persuasive. The Horn et al reference is only relied upon for the teaching of adding potato starch to obtain certain property; thus, the teaching of the inclusion of corn starch is not an issue. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. The discussion about potato starch in the background section in Friedman et al is related to the use of potato starch as the main component, not as an additive as taught in Horn et al which teach to use potato starch in minor amount at level of 1-5%. Thus, availability and price do not play a big factor. Even if the starch is expensive, it would still have been obvious to add it when it provides specific property which is desired. Applicant further argues the use of ungelatinized starch helps to ensure a relative constant viscosity and the use of pregelatinized starch will continually lower the viscosity due to the deterioration of the starch. This argument is not supported by factual evidence because applicant has not done a comparative showing between the two starches. Furthermore, the determination to use ungelatinized or pregelatinized starch to obtain specific function can readily be determined through routine experimentation to obtain the most optimum result. The experiment is not undue and would have been obvious to one skilled in the art because both type of starches are readily available and the testing is not extensive.

Applicant makes reference to the declarations submitted. The second declaration makes the same statements about the use of ungelatinized and pregelatinized as set forth in the response. The declaration is not persuasive for the same reason set forth above.

The other declaration is not found to be persuasive. The declaration gives comments on references which are not used in the rejection; thus, such statements are not germane to the issue in the application. Page 3 of the declaration states none of the prior art suggests a composition which is substantially free of corn starch and is substantially free of starches from plants crossbred or modified to contain either the dull sugary or amylase extender dull. This statement is not consistent with the claims because the claims do not exclude genetically and chemically modified starches. Page 17 states the Friedman patent discloses starch which as a practical matter comprises corn starch. This is not clear what this statement means. Friedman et al disclose the amylose extender gene is present in maize and barley and that cereal grains such as maize contain the dull and sugary-2 genotypes. This disclosure clearly indicates that the starch is not derived solely from corn and can be from barley or other grain as long as the grain contains the required genotypes. Furthermore, even if the starch comes from corn, it is genetically and chemically modified; thus, it is no longer just cornstarch. The starch disclosed in the reference is acetylated starch which is not corn starch. Even if one employs corn to obtain the dull genotype, the resulting plant from which the starch is obtained is not just corn; it is a hybrid between barley and corn. Thus, the

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starch is not a cornstarch. The claims do not exclude genetically and chemically modified corn starch; they only exclude corn starch.

Applicant's arguments filed 4/20/05 have been fully considered but they are not persuasive.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien T. Tran whose telephone number is 571-272-1408. The examiner can normally be reached on Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cano Milton can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 5, 2005

  
LIEN TRAN  
PRIMARY EXAMINER  
*Group 1700*